

### **DETAILED ACTION**

Claims 1-34 are pending

#### ***Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-26, drawn to a composition of silver in water.

Group II, claim(s) 27-28, drawn to a method of disinfecting a surface.

Group III, claim(s) 29, drawn to a method of eliminating danger from bacteria in water.

Group IV, claim(s) 30, drawn to a method of inhibiting viral DNA polymerase.

Group V, claim(s) 31, drawn to a method of inhibiting viral reverse transcriptase.

Group VI, claim(s) 32, drawn to a method of treating a disease.

Group VII, claim(s) 33, drawn to a method of method of treating HIV.

Group VIII, claim(s) 34, drawn to a method of treating hepatitis B.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all, inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical

relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any). Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," should be considered with respect to novelty and inventive step.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical feature in all groups is a composition of silver in water. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art. Yan et al. (US PG PUB No. 2002/0051823) discloses nano-silver containing antibacterial and antifungal granules. Each of the nano-silver particles contains a metallic silver core, which is surrounded by silver oxide. The particles have a diameter from 1 to 1-100 nm. Table 1 is directed to a nano-silver particle containing solution.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### **Elections**

**If Applicant elects Group I, then they must also elect species from the following species elections.**

#### **First Species Election**

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: antimicrobial properties.

Applicant is first required to elect whether the antimicrobial properties **are or are not** antiviral.

If applicant elects that the antimicrobial properties **are** antiviral then Applicant is further required to elect an antiviral property from the following: inhibition of viral DNA polymerase or inhibition of viral reverse transcriptase.

The following claim(s) are generic: 1-11 and 14-26.

### **Second Species Election**

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: formulation of the composition.

Applicant is required to elect whether formulation is an amorphous gel or a solid gel sheet.

The following claim(s) are generic: 1-15 and 18-26.

### **Third Species Election**

This application contains claims directed to the following patentably distinct species: use of the composition

Applicant is required to elect whether the composition is to be used as a personal lubricant or a disinfectant on diaphragms.

The following claim(s) are generic: 1-24.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the silver in water compositions are already known to be useful as antimicrobial agents as well as sexual related diseases (Yan et al.). Additionally the silver in water compositions are already known (Yan et al.).

***Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail Fisher whose telephone number is 571-270-3502. The examiner can normally be reached on M-Th 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718 or Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 4173

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Application/Control Number: 10/563,688

Page 9

Art Unit: 1654

Supervisory Patent Examiner, Art Unit 1654